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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,861	12/21/2001	Jae Soon Kwon	10729-P6746US0	5715

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EXAMINER

TRAN, BINH X

ART UNIT	PAPER NUMBER
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1765

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,861

Applicant(s)

KWON, JAE SOON

Examiner

Binh X Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6 and 7 is/are rejected.
- 7) ☒ Claim(s) 3 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claim Objections

1. Claim 5 is objected to because of the following informalities: In lines 17 and 21 of claim 5, the examiner suggests replacing "epi-layer" with --epitaxial layer-- in order to avoid any confusion whether or not "epi" stands for "epitaxial". Appropriate correction is required.

Double Patenting

2. Applicant is advised that should claim 2, 4 be found allowable, claims 6-7 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

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Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2, 4, 6-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Thei et al. (US 6,350,662).

Thei discloses a method comprising the steps of:

providing a semiconductor substrate (50) where a device isolation region was defined;

forming a mask on the substrate in such manner that the device isolation is exposed through the mask (Fig 3);

etching the substrate using the mask to form a trench (Fig 4, col. 3 lines 46-55);

thermally treating an inner wall of the trench using the mask under hydrogen atmosphere (col. 3 lines 55 to col. 4 line 6);

forming a first insulating layer (66) covering the resulting inner wall of the trench (Fig 5);

forming a second insulating layer (74) on the mask in such a manner that the second insulating film (74) covers the first insulating film (66) (See Fig 7);

firstly etching the second insulating layer (74) to expose a surface of the mask (Fig 8, col. 4 lines 28-35);

removing the mask (58) (See Fig 9, col. 4 lines 35-37);

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secondly etching the remaining second insulating layer (74) until a surface of the substrate (50) is exposed, thereby forming a device isolation film (Fig 9-10; col. 4 lines 37-43).

Respect to claims 2 and 6, Thei teaches the thermal treatment is carried out at a temperature of 800 °C to 900 °C (col. 4 lines 1-5, within applicant's range of 600-1300 °C). Respect to claims 4 and 7, Thei teaches the first and second etch step are carried out using a chemical mechanical polishing or etch back process.

Allowable Subject Matter

5. Claim 3 would objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claim 5 is objected to because of the minor informality as discussed above, but would be allowable if rewritten to correct the minor informality.

7. The following is a statement of reasons for the indication of allowable subject matter: The cited prior arts fail to disclose or suggest the either one of the following step in conjunction with other limitation in the claim: forming an insulating layer covering the resulting of the inner wall of the trench using epitaxial grown process, or forming an epitaxial layer covering the resulting inner wall of the trench.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chen et al. (US 6,306,723) and Yew et al. (US 5,906,299).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh X Tran whose telephone number is (703) 308-1867. The examiner can normally be reached on Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine G Norton can be reached on (703) 305-2667. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Binh X. Tran

NADINE G. NORTON
PRIMARY EXAMINER

